

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

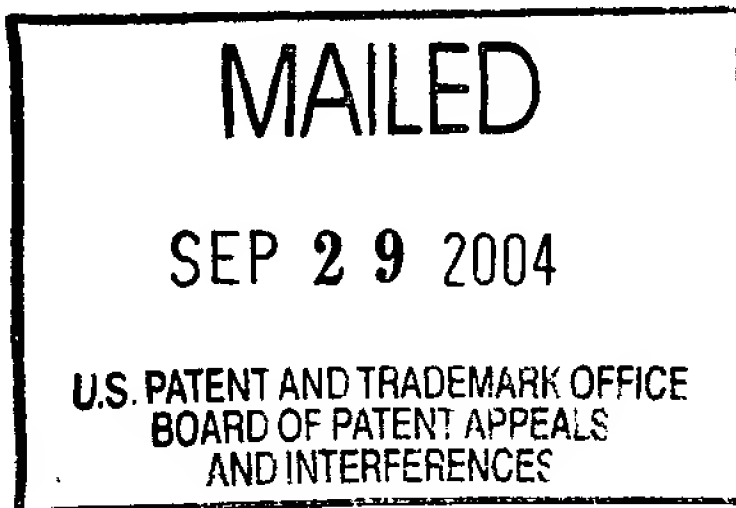
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. SLATER

Appeal No. 2002-0921
Application 09/177,502

ON BRIEF



Before PATE, SCHAFER and LEE, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an **ex parte** appeal from the final rejection of claims 24-29 and 40-56. These are all the claims in the application.

The claimed invention is directed to a blade for an electrosurgical knife used to cauterize and cut tissue

simultaneously. The blade comprises three layers--an inner metal shearing surface, an insulative layer and an outer conductive layer. The claimed subject matter may be further understood by reference to representative claim 24, reproduced below.

24. An endoscopic scissor blade for use in a bipolar endoscopic instrument, said blade comprising:

- a) an inner metal shearing surface;
- b) an intermediate electrically insulative layer;
- c) an outer metal conductive layer which is electrically insulated from said inner metal shearing surface by said intermediate electrically insulative layer; and
- d) means for coupling a source of voltage to said outer metal conductive layer.

The Rejections

The examiner has rejected appellant's claims 24, 25, 28, 29, 40, 41, 44, and 46-56 under 35 U.S.C. § 102(g). The examiner states that:

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See ***In re Oguie*** [***sic, Ogiue***], 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Appeal No. 2002-0921
Application 09/177,502

The examiner has rejected claims 26, 27, 42, 43, and 45 under 35 U.S.C. § 102(g)/103(a). According to the examiner, the subject matter of these claims would have been obvious over the subject matter of claims 1-11 of U.S. Patent 5,352,222.

The examiner has further rejected all claims on appeal based on interference estoppel under 37 CFR § 1.658(c).¹ The examiner is of the view that appellant's failure to move under 37 CFR § 1.633(c)(1) to add the subject matter of the appealed claims to the interference renders appellant estopped to assert the subject matter as patentable in this **ex parte** context.

We have carefully reviewed the claims on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we make the following findings of fact and conclusions of law.

Background Facts

1. The rejections at issue in this appeal had their genesis from the circumstances in terminated Int. No. 103,765.

¹ As of September 13, 2004, the estoppel provision is found in 37 CFR § 41.127(a).

Appeal No. 2002-0921
Application 09/177,502

2. They are based on appellant's alleged failure to move to add the subject matter of the appealed claims to the interference.

3. Interference No. 103,765 was declared on October 6, 1996.

4. The subject matter in interference was directed to a bipolar electrosurgical instrument that would both cut and cauterize tissue simultaneously. The original Count 1 in interference reads as follows:

Count 1

A bipolar electrosurgical scissors comprising:

a) first and second blade members each comprising an assembly of a metal shearing surface, an electrically conductive electrode, and an intermediate electrically insulative material disposed between and fixed to the metal shearing surface and the electrically conductive electrode;

b) means coupled to at least one of said first and second blade members for imparting scissors-like movement relative to the other of said first and second blade members; and

c) means for applying a voltage between the electrically conductive electrodes of said first and second blade members.

5. Appellant Slater was junior party in the interference.

Slater's involved application was 08/354,992 filed on

December 13, 1994. The application on appeal is said to be a

divisional application of 08/354,992. The real party in interest is Symbiosis Corporation which is owned by Boston Scientific Corporation.

6. The senior party in interference was Mark A. Rydell. Rydell was involved on his U.S. Patent No. 5,352,222 granted on October 4, 1994, application 08/213,671 filed March 15, 1994.

The real party in interest was Everest Medical Corporation.

7. As filed, Slater's involved application not only contained claims directed to an electrosurgical instrument, it also contained claims directed to the subcombination invention of a blade for use in an electrosurgical scissors. See claim 24, reproduced above.

8. When the interference was declared, Slater claims 24-29 directed to the subcombination blade **per se** were designated as not corresponding to the scissors count in interference.

9. During the preliminary motion phase of the interference, Rydell sought to reissue the involved Rydell patent. In a motion decision mailed on July 20, 1998, the Rydell Reissue application 08/724,997 was added to the interference. After the interference was concluded, the Reissue application was issued on July 25, 2000 as Re. 36,795.

10. Also during the preliminary motion phase of the interference, Rydell moved to copy Slater claims 24-29 into his

reissue application. As noted above, these claims are directed to the subcombination invention of the blade **per se**. The motion was opposed by Slater on the ground of Reissue recapture.

11. During prosecution of the involved Rydell patent, the examiner required restriction between claims directed to an electrosurgical scissors, claims directed to the subcombination blade for such a scissors, and a method of making a scissors blade. The subcombination claims that were not elected for prosecution by Rydell were claims 1-9 directed to a blade assembly for an electrosurgical instrument. Cancelled Claim 1 of the Rydell application is representative and reads as follows:

1. A blade assembly for an electrosurgical instrument comprising:

(a) a metal blade member having a shearing surface and a honed cutting edge;

(b) a metal blade support; and

(c) an electrically insulating bonding/spacing layer disposed intermediate said blade member and said blade support along the entire length of said blade member.

12. During prosecution of the involved Rydell patent, Rydell elected the claims directed to the electrosurgical instrument. Claims directed to the blade **per se** and a method of making the

blade were cancelled at the time of allowance. Rydell did not file a divisional application claiming the blade **per se**.

13. Thus, when Rydell moved to copy the Slater blade claims into the Rydell reissue application during the interference, Slater opposed. The Administrative Patent Judge (APJ) determined that failure to file a divisional application is not "error" under 35 U.S.C. § 251. Accordingly, the APJ held in the interlocutory decision that Rydell was barred from copying Slater claims 24-29 directed to a blade **per se** and refused to allow Rydell to add these claims or to add an additional count to the interference.

14. After the motion decision in the interference, Slater filed a motion for entry of Adverse Judgment on October 6, 1998 (37 CFR 1.662(a)). The interference was terminated adverse to Slater on January 13, 1999.

15. Slater is a losing party under 37 CFR § 1.658(c).

16. The scope of the blade claims Rydell sought to add to the reissue application during the interference and successfully added during ex parte prosecution after the interference are of generally the same scope as the blade was claimed in the combination subject matter granted in the original Rydell patent.

Decision

Rejections under 35 U.S.C. §§ 102(g) and 103(a)

Turning first to a consideration of the rejection of claims 24, 25, 28, 29, 40, 41, 44, and 46-56 under 35 U.S.C. § 102(g), we do not sustain this rejection. The simple explanation is that appellant's claims, directed to the blade *per se*, were designated as not corresponding to the count in interference. Accordingly, they were not at issue in the interference, and no priority determination with respect to these claims has been adjudicated. Since they were designated as not corresponding to the count, they are, by definition, not the same invention as the "lost count," and cannot be considered to be prior invention by another under the statute. Consequently, the examiner's rejection on the ground of 35 U.S.C. § 102(g) does not have a legitimate basis.

Similarly, with respect to the rejection of claims 26, 27, 42, 43, and 45 under 35 U.S.C. § 102(g)/103(a), since the invention of the independent claim has not been found to be the prior invention of another under the statute, there is no subject matter that is the invention of another in the prior art that

Appeal No. 2002-0921
Application 09/177,502

would have rendered obvious the subject matter of these claims to one of ordinary skill at the time the invention was made by appellant. The rejection of claims 26, 27, 42, 43, and 45 on obviousness grounds is reversed.

Estoppel under 37 CFR § 1.658(c)

The rejection by the examiner of claims 24-29 and 40-56 on the basis of estoppel is clearly based on the common disclosures of Rydell and Slater and the fact that the patent and application respectively were involved in interference 103,765. It is well settled that for the estoppel to be viable, Rydell must have been able to claim this common subject matter at the time of the interference. **See *In re Wilding***, 535 F.2d 631, 634, 190 USPQ 59, 62 (CCPA 1976); ***In re Risse***, 378 F.2d 948, 954, 154 USPQ 1, 6 (CCPA 1967). Accordingly, we now turn to the issue of whether the APJ's decision refusing to allow Rydell to add the blade claims to the interference was correct.

Appeal No. 2002-0921
Application 09/177,502

Should Rydell have been permitted to add claims directed to a blade *per se* to the interference?

To determine whether Slater is entitled to the subject matter of the claims in issue, we must first determine whether Rydell was entitled to add claims directed to the subject matter of blades ***per se*** to the interference. This is necessary inasmuch as the APJ ruled in the Decision on preliminary motions that Rydell was not entitled to add this subject matter. The Examiner that allowed the Rydell Reissue application had a different view.

The Federal Circuit and its predecessor court have long held that failure to file a divisional application after a restriction requirement is not an error correctable under the Reissue statute, 35 U.S.C. § 251. ***In re Watkinson***, 900 F.2d 230, 231, 14 USPQ2d 1407, 1409 (Fed. Cir. 1990). ***See In re Orita***, 550 F.2d 1277, 1281, 193 USPQ 145, 149 (CCPA 1977) (section 251 "is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure."). In fact, it matters not whether the restriction requirement was or was not proper. ***Watkinson***, 900 F.2d at 231, 14 USPQ2d at 1409.

The presence of claims directed to a blade **per se** in the Rydell Reissue patent is problematic. Rydell apprised the examiner of the interlocutory decision of the APJ respecting the entitlement of Rydell to add that claimed subject matter. Also, the record shows that the examiner reviewed the interference file which contained the interlocutory decision of the APJ. When Rydell introduced an amendment to the Reissue application, Rydell stated on pages 11-12 of Paper No. 15 that the blade claims copied from Slater and included in the Reissue application contain an additional element, element d. Therefore, Rydell evidently was of the view that it was incorrect on the part of the APJ to hold that these claims were directed to the same invention as the claims cancelled in the parent application. The examiner allowed the blade claims without further comment, presumably because they contained this additional element.

Of course, whether the claims contain an extra element or not is not the proper criterion for determining whether Rydell should have been allowed to add the subject matter of the blade subcombination **per se** to the interference.

In this matter, it is instructive to consider the holding in ***In re Cornell***, 150 F.2d 702, 704, 66 USPQ 320, 322 (CCPA 1945) cited with approval in ***Orita***, 550 F.2d at 1279-80, 193 USPQ at 148. ***See also Ex parte Holt***, 218 USPQ 747, 748 (Bd. Pat. App. 1982) and ***In re Doyle***, 293 F.3d 1355, 1358, 63 USPQ2d 1161, 1164 (Fed. Cir. 2002). The invention in ***Cornell*** was a repeating valve shut-off system for dispensing a measured amount of liquid such as lubricating oil. The system comprised the combination of a pump which received the liquid to be measured and dispensed from a main storage tank, a liquid measuring apparatus or meter, and a shut-off valve. A provision was made for adjusting the liquid measuring apparatus or meter in accordance with the temperature of the liquid so that the measurement of the liquid would be accurate regardless of the temperature of the liquid. During prosecution of the original application, appellants elected to prosecute claims drawn to the combination invention, i.e., a pump, liquid measuring apparatus, and shut-off valve. Claims directed to the liquid measuring apparatus ***per se*** were non-elected and cancelled prior to allowance of the combination claims. After the grant of the combination patent, the patentees

filed a reissue application directed to the liquid measuring apparatus **per se**. The Court of Customs and Patent Appeals stated that after deliberately withdrawing all claims to the measuring apparatus **per se** in response to the examiner's restriction requirement, appellants cannot successfully contend that their failure to include claims in their patent to the measuring apparatus **per se** was due to inadvertence, accident or mistake. The holding of the Court was as follows:

We hold, therefore, that appellants are not entitled to obtain, by reissue, claims, **regardless of scope**, which are limited to the liquid measuring apparatus. . . .
Cornell, 150 F.2d at 704, 66 USPQ at 322 (emphasis added).

Also pertinent to the present situation is that in **Cornell** the scope of the appealed claims much more closely resembled the scope of the original patent claims than cancelled claims 24 and 25 of the original application. The court stated that this was not of vital consequence. That the newly sought claims were directed to the subcombination measuring apparatus claimed in more detail was not the issue. The issue was that the appellants had elected to claim the combination and had made a conscious

decision not to file a divisional application directed to the subcombination apparatus, even if it were claimed in more detail.

Turning to the instant situation, in the original Rydell application, Rydell included claims drawn to an electrosurgical scissors, a method of making the scissors, and the subcombination electrosurgical scissors blade **per se**. Claims drawn to the method and the scissors blade **per se** were cancelled prior to issuance of the patent. The reissue application of Rydell was filed well after the grant of the Rydell patent. It included claims directed to an electrosurgical scissors blade **per se**. By analogy to the **Cornell** decision, it is clear that Rydell was not entitled to add to the interference, claims, regardless of scope, which are limited to the electrosurgical blade **per se**, as ruled by the APJ during the interference.

Additionally, just as in **Cornell**, the scope of the reissue claims to the blade **per se** matches closely the scope of the blade claimed in Rydell's original patent. However, just as in **Cornell**, the scope is not of vital consequence.

Since we have determined that Rydell was not entitled to add claims to the interference directed to the subject matter

Appeal No. 2002-0921
Application 09/177,502

of the subcombination electrosurgical blade **per se**, under the interference estoppel doctrine as articulated in **Wilding** and **Risse** and later included in 37 CFR § 1.658(c), no estoppel can lie against appellant for failure to move under 37 CFR § 1.633 to add the claimed subject matter in this appeal to the interference.

The rejection of all claims on appeal under estoppel pursuant to 37 CFR § 1.658(c) is reversed.

We acknowledge that appellant requests that an additional interference be set up between the Rydell reissue and the application on appeal. This matter will be reviewed by the Primary Examiner after the conclusion of this appeal.

Appeal No. 2002-0921
Application 09/177,502


Summary

All rejections of claims 24-29 and 40-56 on appeal are reversed.

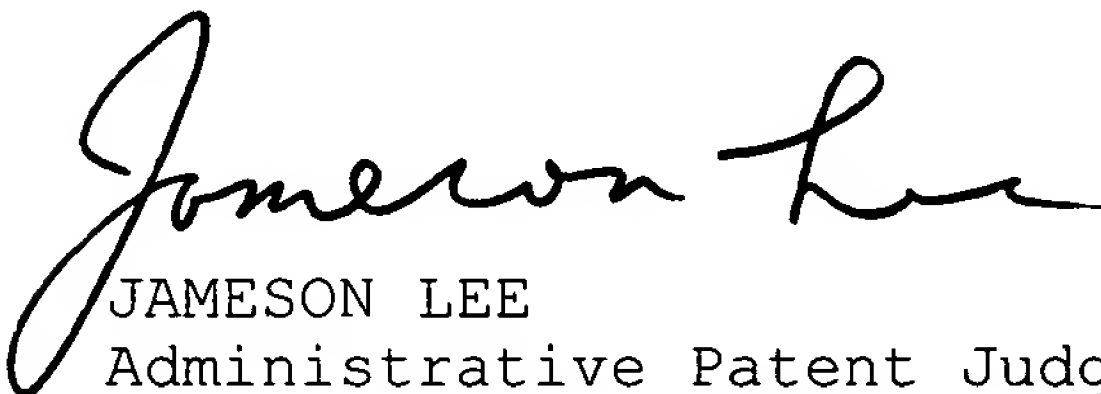
REVERSED



WILLIAM F. PATE, III
Administrative Patent Judge



RICHARD E. SCHAPER
Administrative Patent Judge



JAMESON LEE
Administrative Patent Judge

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Appeal No. 2002-0921
Application 09/177,502

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
1300 I Street, N.W.
Washington, D.C. 20005